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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,939	02/14/2000	Andrew H. Gafken	2207/8478	7313
23838	7590	07/21/2006	EXAMINER	
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			SONG, HOSUK	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/503,939	GAFKEN ET AL.	
	Examiner	Art Unit	
	HOSUK SONG	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10,16-24,26 and 28-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-24 and 33-36 is/are allowed.
- 6) ☒ Claim(s) 7-10,16,17,20,26,28,29 and 31 is/are rejected.
- 7) ☒ Claim(s) 18,19,21,30 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20060719</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20060719</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Wisor(US 6,823,435).

Claim 7: Wisor disclose upon restart of the processor,determining whether memory contains a BIOS package and authenticating the BIOS package in (col.1,lines 47-56). Wisor disclose upon successful authentication storing the BIOS package in a reprogrammable BIOS memory space in (col.1,lines 57-61;col.4,lines 16-18).

2. Claims 9-10,26,28,29,31 are rejected under 35 U.S.C. 102(e) as being anticipated by Leavitt et al(US 5,918,047).

Claims 9-10: Leavitt disclose a processor, firmware electrically connected to the processor, the firmware comprising a first storage space to store a first system BIOS, the first storage space being a read only memory in (fig.1;col.2,lines 46-50). Leavitt disclose a second storage space to store a second system BIOS and an index table, the index table associating elements of the second system BIOS with elements of the first system BIOS in (fig.1;col.3,lines 58-67).

Claim 31: Leavitt disclose determining whether a video BIOS package is present in an enhancement space of firmware, if the video BIOS package is present,determining whether a predetermined user command has been entered,if the predetermined user command has not been entered,executing the video BIOS package from the enhancement space,otherwise,executing a video BIOS from a default space of firmware in (col.3,lines 45-67 and fig.1).

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Claims 26,28,29: Leavitt disclose during execution of a system BIOS, determining whether a first video BIOS exists in an alterable firmware section of a memory system and if no video exist in the alterable section, executing a second video BIOS in a nonalterable firmware section in the memory system in (fig.1 and col.3,lines 45-67).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Le et al.(US 5,794,054).

Claim 7: Le disclose upon restart of the processor,determining whether memory contains a BIOS package and authenticating the BIOS package in (col.1,lines 44-52). Le disclose upon successful authentication storing the BIOS package in a reprogrammable BIOS memory space in (col.1,lines 58-64).

4. Claims 16-17,20, are rejected under 35 U.S.C. 102(b) as being anticipated by Christeson et al.(US 5,579,522).

Claims 16,17: Christeson disclose executing a system BIOS from a default memory space,executing an ancillary BIOS according to determining whether an ancillary BIOS exists in an alterable memory space, if no ancillary BIOS exists in the alterable memory space,executing an ancillary BIOS from the default memory space in (fig.2,3A,3B and col.5,lines 39-65).

Claim 20: Christeson disclose determining whether an ancillary BIOS package is present in an enhancement space of firmware,if the ancillary BIOS package is present,determining whether a predetermined user command has been entered, if the predetermined user command has not been entered ,executing the ancillary BIOS package from the enhancement space,otherwise,executing an ancillary BIOS from a default space of firmware in (fig.2,3A,3B and col.5,lines 39-65).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wisor(US 6,823,435) and Le et al.(US 5,794,054)

Claim 8: Neither Wisor nor Le specifically disclose determining whether the BIOS package is successfully stored in the reprogrammable BIOS memory space, if so, report a success flag identifying the BIOS package as successfully stored. Official notice is taken that this is well known in the art. One of ordinary skill in the art would have been motivated to include a success flag identifying the BIOS package as successfully stored in order to alert the user that system is operating accordingly without any errors.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The claimed invention is directed to non-statutory subject matter.

Claims 9,10 : Claim lacks concrete and tangible result. A useful, concrete and tangible result must be specifically recited in the claim.

Allowable Subject Matter

7. Claims 18,19,21,30,32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 22-24,33-36 are allowed.

Response to Applicant's Arguments


9. The previous rejections are withdrawn in view of applicant's arguments filed on 7/7/06. However, newly discovered prior art has necessitated new grounds of rejection. The delay in citation of newly discovered prior art is regretted.

USPTO Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosuk Song whose telephone number is 571-272-3857. The examiner can normally be reached on Tue-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Hosuk Song
Primary Examiner
Art Unit 2135